

REMARKS

Applicants have carefully reviewed the Application in light of the Final Office Action mailed February 12, 2004. Claims 1, 2, 4-14, 16-26, 28-32, 34-38, and 40-46 remain pending in the Application and stand rejected. Applicants amend Claim 34 to correct a typographical error.

I. Claim Objections

The Examiner objects to Claim 34 as improperly depending upon a previously canceled claim. Applicants appreciate the Examiner's thoroughness in evaluation and amend Claim 34 to properly depend on Claim 32. Applicants respectfully request the Examiner to provide an acknowledgement in an Advisory Action indicating whether or not the amendment has been entered.

II. Section 103 Rejections

The Examiner rejects Claims 1, 2, 4-14, 16-26, 28-32, 34-38, and 40-46 under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 6,039,244 to Finsterwald ("*Finsterwald*") in view of U.S. Patent No. 6,450,407 to Freeman, et al. ("*Freeman*"). Applicants respectfully traverse the rejection.

A. The Finsterwald-Freeman Combination Fails To Teach Or Suggest All Elements.

Applicants respectfully submit that the *Finsterwald-Freeman* combination fails to teach or suggest all elements of Claims 1, 2, 4-14, 16-26, 28-32, 34-38, and 40-46. Consider Applicants' Claim 8, which recites:

8. An apparatus for rebate processing, comprising:
 - a first memory operable to store promotion information describing a plurality of promotions, the promotion information comprising, for each of the promotions, a promotion sponsor identifier, a promotion identifier, promotion requirements, and at least one disbursement option;
 - a second memory operable to store transaction information indicating a plurality of product purchases, the transaction information comprising, for each of the purchases, a consumer identifier, a rebate request status, and a promotion identifier matching to a selected one of the promotions; and
 - a processor operable to process rebate requests by associating the product purchases with the promotions using the promotion identifiers and

determining whether selected transaction information for the purchases satisfies the rebate requirements for the promotions, the processor further operable to provide rebate status updates to the consumers using the rebate request statuses and to generate promotion reports, a promotion report comprising selected promotion information for at least one of the promotions having a particular promotion sponsor identifier.

Applicants respectfully submit that *Finsterwald* and *Freeman*, taken alone or in combination, fail to teach or suggest all elements of this claim. For example, Claim 8 includes:

a processor operable to process rebate requests by associating the purchases with the promotions using the promotion identifiers and determining whether selected transaction information for the purchases satisfies the rebate requirements for the promotions, the processor further operable to provide rebate status updates to the consumers using the rebate request statuses and to generate promotion reports, a promotion report comprising selected promotion information for at least one of the promotions having a particular promotion sponsor identifier.

None of the cited references teach or suggest this element and its operation.

In general, *Finsterwald* teaches specific techniques for enabling rebate or coupon systems. More specifically, *Finsterwald* teaches a system that generates unique codes and then distributes these codes to consumers purchasing particular products. See, e.g., *Finsterwald*, at column 1, lines 41-65. For example, one of the unique codes may be printed on the internal packaging of a product. A consumer, having received a unique code at purchase, can then submit the code to receive “points” that may later be redeemed for other products or services. *Finsterwald*, at column 2, lines 19-33. The *Finsterwald* system may store these points in an account created for the consumer. *Finsterwald*, at column 9, lines 16-25. After a code has been redeemed, that code is then canceled. *Finsterwald*, at column 9, lines 57-61. This prevents subsequent attempts to redeem the identical code. Thus the unique codes of the *Finsterwald* system add security, since the system knows all valid codes and permits redemption of each code only once. *Finsterwald*, at column 2, lines 46-61 and column 9, lines 57-61.

No Teaching of Rebate Status Updates

In rejecting the claims, the Examiner addresses selected claimed aspects by reference to the point account of *Finsterwald*. For example, the processor element of Applicants’

Claim 8 is “operable to provide rebate status updates to the consumers using the rebate request statuses.” As teaching for this aspect, the Examiner cites to column 10, lines 21-25 of *Finsterwald*. This portion of *Finsterwald* explains that a consumer can access his “point account” to determine how many points have been accumulated. However, *Finsterwald*’s disclosure of a point account balance simply does not teach the claim requirements. Claim 8 requires a second memory that maintains, for each of the purchases, a rebate request status. Claim 8 further requires a processor “operable to provide rebate status updates to the consumers using the rebate request statuses.”

The instantaneous nature of *Finsterwald*’s rebate operations teach away from any such operation. *Finsterwald* teaches that points are credited immediately to a consumer’s point account upon receiving a valid code. *Finsterwald*, at column 9, lines 41-44. Thus *Finsterwald* does not disclose any rebate request transaction that remains pending such that status updates would be appropriate. Moreover, the instantaneous nature of the *Finsterwald* system teaches away from maintaining rebate request status on a purchase by purchase basis.

***The Examiner’s Rebuttal Highlights
the Deficiencies of Finsterwald***

In the Final Office Action, the Examiner maintains his earlier rejection and provides a rebuttal to the preceding arguments. In this rebuttal, the Examiner specifically addresses Applicants’ arguments regarding the rebate status capabilities required in the claims. For these capabilities, the Examiner again cites to the point accounts, but also cites to the database of unique codes maintained by the *Finsterwald* system. As earlier discussed, a point account simply indicates how many rebate points have been accumulated by a user. The unique codes provide a security mechanism whereby the *Finsterwald* system can verify valid requests. Prior to use, a code is not associated with any particular account. After use, a code is canceled and remains not associated with any particular account. *Finsterwald*, at column 9, lines 57-61. *Finsterwald* details no link between the codes and particular point accounts. However, the Examiner links these two aspects of *Finsterwald*, stating:

Since this information [unique codes] is stored in the same system which maintains the customer’s account status information [point balance] and since the customer has access to this status information [point balance], it is inherent that the customer can be provided with access to any of the information stored in the system.

Final Office Action, at page 9 (sic).

This statement, however, ignores a fundamental concept behind *Finsterwald*. Customers should not be able to access the unique codes maintained in the *Finsterwald* system. To permit customers this access would destroy the security of the system. Moreover, the *Finsterwald* system provides no mechanism to permit access to unique codes on an account by account basis, since the codes are not associated with any particular account. Thus the Examiner's proposed operation of *Finsterwald* would destroy the operation of the *Finsterwald* system.

The Examiner continues by mischaracterizing the rebate status maintained in Applicants' claims, stating:

[T]he Examiner notes that since the Applicant's invention also uses a computer system to automatically process the rebates, it too would only maintain a rebate status for a few milliseconds, at most, while the processor completed the rebate transaction.

Final Office Action, at page 9. However, the rebate status as claimed and as described in Applicants' specification contemplates far more than a mere millisecond of information. For example, consider Figure 4 of Applicants' original filing and the associated text at page 14, lines 17-24. This describes the nature of rebate status in a particular embodiment, stating:

Rebate status provides an indication of the current state of a rebate request from consumer 22, for example, transaction initiated, awaiting rebate request form 24, processing information, awaiting verification, rebate request form 24 invalid, request denied, request approved, awaiting disbursement option 66 selection, fulfilling disbursement option 66, processing complete, or any other suitable status designation.

This rebate status is a far cry from a point account or a database of codes.

Therefore, the Examiner's rebuttal simply highlights deficiencies of *Finsterwald* with respect to the rebate status aspects of the claims.

No Teaching of Promotion Reports

The Examiner admits that *Finsterwald* fails to disclose the claimed aspects of generating promotion reports for sponsors. Final Office Action, at page 4. As teaching for these aspects, the Examiner cites to *Freeman*, at column 11, lines 16-20, which recites:

Records of electronic money rebate payments to users may be maintained in a database for a time period for the purpose of permitting audits of the payment data by the manufacturers or other party that is paying for the rebates.

However, simply maintaining payment records for potential audits does not show the processor of Claim 8, operable “to generate promotion reports, a promotion report comprising selected promotion information for at least one of the promotions having a particular promotion sponsor identifier.”

This deficiency of *Freeman* is highlighted even more dramatically in the Examiner’s attempt to show the elements of dependent Claim 13, which recites:

13. The apparatus of Claim 8, further comprising an interface operable to communicate one of the promotion reports to a promotion sponsor, the communicated promotion report comprising a number of rebate requests and a breakage rate for each promotion associated with the promotion sponsor.

In addressing this claim, the Examiner states:

Freeman further discloses the promotion reports includes [sic] all pertinent information about the rebate program, such as number of rebates, breakage rate, name and addresses or requestors, etc. (col 11, lines 16-29).

Office Action, at page 4 (underline in original). However, an examination of the cited language reveals no mention of “pertinent information about the rebate program, such as number of rebates, breakage rate, name and addresses or requestors, etc.” *Freeman*’s disclosure of payment records and associated reconciliation efforts simply does not teach promotion reports as claimed in Claims 8 or 13.

***The Examiner’s Rebuttal Again
Highlights the Deficiencies of Finsterwald***

Applicants respectfully submit that the Examiner’s rebuttal of the preceding arguments again highlight the deficiencies of *Finsterwald*. The Examiner begins this rebuttal by stating:

The Applicant argues that Finsterwald does not disclose generating promotion reports for sponsors (pages 13-14).

Final Office Action, at page 10 (sic) (underline in original). Applicants respectfully note that this “argument” is merely Applicants’ restatement of the Examiner’s position. The Examiner states in the preceding office action and this Final Office Action that:

Finsterwald does not explicitly disclose generating promotion reports for sponsors.

Final Office Action, at page 4 (underline in original). In rebuttal of this “argument” of Applicants, the Examiner points to data that may be collected by the *Finsterwald* system. However, the collection of data does not teach, either expressly or inherently, the promotion report capabilities required by the claims. Therefore, the Examiner’s rebuttal again highlights deficiencies of *Finsterwald* with respect to the claims.

Claims 1, 20, 40 And 43 And Dependents

Independent Claims 1, 20, 40 and 43 include limitations that, for substantially the same reasons as discussed with respect to Claim 8, are not shown by the cited references. The claims depending from these independent claims add further patentable limitations. Moreover, Applicants respectfully submit that the Examiner has failed to address specific aspects of Claims 40 and 43. For example, the second memory of Claim 40 is operable to store transaction information that, for a particular product purchase, includes:

a rebate transaction identifier assigned in response to a request for a rebate received from the consumer [and] rebate request information indicating a rebate request materials submission date

However, the Examiner fails to address these limitations. Applicants respectfully submit that these and other elements of these claims provide patentable distinctions with respect to the *Finsterwald-Freeman* combination.

The Examiner Fails To Address Claim 32

Applicants note that independent Claim 32 recites an interface for facilitating rebate processing that includes a number of limitations not addressed by the Examiner and not shown in the cited references. Applicants respectfully submit Claim 32 and its dependent claims are patentably distinct from the *Finsterwald-Freeman* combination.

Applicants Request Allowance Of All Claims

For at least the reasons discussed above, Applicants respectfully submit that the proposed *Finsterwald-Freeman* combination fails to teach, suggest, or disclose all elements of Applicants' claims. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection to the claims based upon the *Finsterwald-Freeman* combination.

B. The Combination Of Finsterwald And Freeman Is Improper

In addition, Applicants respectfully submit that the combination of *Finsterwald* and *Freeman* is improper. As noted above, the cited portions of *Freeman* deal with maintaining payment records for potential audits. In contrast, *Finsterwald* discloses a point collecting system that does not contemplate making payments to consumers. Thus *Finsterwald* has no need for payment record-keeping and does not contemplate combination with a payment record-keeping reference.

Moreover the Examiner's statements regarding motivation focus on potential advantages of Applicants' claims to explain motivation for the combination. The Examiner states:

One would have been motivate to generate such reports for the sponsors in view of Finsterwald's disclosure that maintaining demographic and transaction histories for the customers and for generating targeted messages based on such an information. Generating reports for the sponsors of these promotional programs would enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better.

Final Office Action, at page 3 (sic) (underline in original). However, as previously noted, the cited portions of *Freeman* deal with maintaining payment records for potential audits. The Examiner fails to show how maintaining these audit records can "enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better." Thus while the Examiner does cite to a potential advantage of Applicants' claimed invention, the Examiner fails to show how the cited references provide this advantage. Moreover, Applicants respectfully submit that this proposed reason for the combination simply represents impermissible hindsight reconstruction.

In rebuttal of this argument, the Examiner makes three points. First, the Examiner argues that a common field of endeavor makes the combination obvious, stating:

In this case, both references pertain to process rebates on purchased products or services, both references further disclose tracking and storing data pertaining to the customer and the rebate. Therefore, it would have been obvious to one attempting to set up a rebate processing system to select one or more features from one reference to combine with features from the other reference.

Final Office Action, at page 11 (sic). However, generally addressing a common field of endeavor does not inherently provide a motivation to combine. Moreover, Applicants have shown that despite the fact that both references mention rebates, there is no need and certainly no motivation to add the audit record-keeping features of *Freeman* to *Finsterwald*.

Second, the Examiner argues that laws of local jurisdictions may require maintenance of financial records. However, the Examiner identifies no financial records of *Finsterwald* to maintain, nor does the Examiner identify any actual laws that may have such a requirement.

Third, the Examiner argues that, even without any such legal requirements, *Finsterwald* would have had other motivations, such as audits and tax filings, to maintain financial records. Again, however, the Examiner identifies no financial records of *Finsterwald* to maintain.

Applicants have thus shown that there is no motivation to combine the references, and that the proposed combination of the references is improper. Therefore, Applicants respectfully request that the Examiner withdraw the rejection to the claims based upon the *Finsterwald-Freeman* combination.

CONCLUSION

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner. Applicants believe that no filing fee is due. However, the Commissioner is hereby authorized to charge any appropriate fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a stylized flourish at the end.

Kurt M. Pankratz
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